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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,886	01/26/2004	Andrea Fiorenzo Becocci	71277	9694

23872 7590 11/02/2004

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SCARBOROUGH, NY 10510-0827

EXAMINER
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SCHWARTZ, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

10/764,886

Applicant(s)

BECOCCI ET AL.

ST

Examiner

Christopher P. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-344)
- 6) ☐ Other: \_\_\_\_.

CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sleeve, as claimed in claims 2,4 must be shown or the feature(s) canceled from the claim(s). **No new matter should be entered.**

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The abstract of the disclosure is objected to because the word "said" should be removed from the abstract. The reference to fig 1 should be removed. Numerals used in the abstract should be used to identify all structural features or none at all. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: the specification appears to be a literal translation of the foreign document as it contains numerous grammatical and idiomatic errors throughout.

Applicants should consider the submission of a substitute specification.

In the specification at page 4 line 12 it is unclear what is meant by "oil stuffing 72" and "counteracting 73".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2,4 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It

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is unclear what applicant considers to be the sleeve since it has not been shown in the drawings.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1 line 1 "and the like" is unclear. What exactly are the metes and bounds of "and the like"? The phrase "in particular" is considered to be a range within a range limitation since it becomes unclear what applicant is seeking patent protection on – the broader range of the brakes or the narrower range of disc brakes.

Claims 2 and 4 "the sleeve" lacks antecedent basis.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1- rejected under 35 U.S.C. 102(b) as being anticipated by Andrus.

Regarding claim 1, subject to the 112 rejections above, Andrus discloses as best seen in figure 6 an apparatus for the control of brakes in bicycles comprising a pump 60,64,108,90,94, as broadly claimed, capable of pushing fluid into a hydraulic circuit 62 wherein the pump is held inside the handlebar or a part associated therewith.

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Regarding claim 2, as best understood, note that Andrus discloses a sleeve at 54 and a lug, as broadly claimed, at 126 or 128.

Regarding claims 4 and 5 these requirements are met.

Regarding claims 11 and 12 note the reservoir at 74 and the cover member at 84 in figure 6.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus in view of Modolo.

Regarding claim 3 to have modified the device of Andrus so that it can be actuated inside "the two arms" as broadly claimed, of a racing type handle-bar would have been obvious in view of the teachings of Modolo to offer a more streamlined and aerodynamic setup. See Modolo column 1 lines 47-49 and claim 4.

Regarding claim 7, as discussed above these requirements are met.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus in view of Sule.

Regarding claim 6 although Andrus does not specifically show a "control rod" in the connection of the lever 104,108 with the piston 90 such a structure is known and is fairly taught by Sule at 44. To have modified the device of Andrus according to the

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teachings of Sule would merely amount to an obvious alternative choice of design to that of Andrus due to the function and close similarity in structure of the brake devices.

12. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus in view of Modolo as applied to claim 3 above, and further in view of Sule.

The discussion above is relied upon for a rejection of claim 8.

13. Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus in view of Leitner.

Regarding claim 9 Andrus lacks a specific showing of the piston—cable—lever connection.

Leitner teaches this well known alternative connection at 26,28 and 70,72. See figure 3 and the discussion in column 8 lines 19-23.

One having ordinary skill in the art at the time of the invention would have found it an obvious alternative equivalent means of actuating the piston assembly of Andrus using a lever-cable connection as taught by Leitner. Such a change in design may be due to specific handlebar type and/or rider preferences.

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus in view of Leitner and Le Marchand or D'Aluisio.

Regarding claim 10 the discussion above is relied upon for an explanation of Andrus as modified by Leitner.

Lacking in this combination is the specific limitation of the piston being pushed by the sheath.

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However it is well known in the art to make use of the reactive forces of the sheath covering a cable to actuate certain brake elements. See Le Marchand col. 5 lines 29-31. See D'Aluisio column 1 lines 35-45.

One having ordinary skill in the art at the time of the invention would have found it obvious to have made use of the reactive force of the cable sheath to actuate the piston in Andrus as modified by Leitner, as taught by Le Marchand or D'Aluisio, simply as a part of an alternative equivalent brake actuating means taught by Leitner, as applied to Andrus.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited have been cited for showing related concepts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 703-308-0576. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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10/29/04